Supreme Court, U.S.
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No. 85-2113

IN THE

Supreme Court of the United States

OCTOBER TERM, 1986

A. H. ROBINS COMPANY, INC.,

Petitioner,

v.

ELI LILLY AND COMPANY,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S RESPONSE TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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35 U.S.C. §103 1

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At issue here is the role of *Graham v. John Deere*, 383 U.S. 1 (1966) in the resolution of the issue of patent validity under 35 USC §103.

The matter is of enormous importance to the patent bar, to the district courts, and to industry and commerce generally, despite respondent's protestations that the case at bar is a parochial dispute of interest only to the litigants.

Respondent's complaint that "the case presents no conflict between jurisdictions" highlights the need for this Honorable Court's intercession. Because the Federal Circuit is the sole appellate authority in questions of patent law, conflicts between jurisdictions in questions of patent law are a thing of the past. Petitioner

urges error, not conflict, to invoke this Honorable Court's power of review.

Because the Federal Circuit is a national circuit its error is of national import. the action of this unique circuit should be uniquely subject to this Honorable Court's scrutiny.

Petitioner respectfully suggests that the Federal Circuit's improper invokation of *Graham* simply to void district courts' holdings of patent invalidity merits this Honorable Court's immediate attention.

The cases cited at page 6 of the Petition herein display the unbroken pattern of reversal or remand when a district court has held a patent invalid without making the *Graham* findings in the exact form desired by the Federal Circuit.

Very recently the court has once more engaged in this process. In *Bausch & Lomb Inc. v. Barnes-Hind/ Hydrocurve Inc. et al,* No. 85-2578 (Fed. Cir. July 14, 1986) the court, faced with an unpalatable holding of invalidity remanded with instructions to make the detailed *Graham* findings.

The Federal Circuit has never played it the other way around. The Federal Circuit has never, as far as can be determined, criticized a district court for failure to make the *Graham* findings when the district court has found the patent valid.

Petitioner here is a victim of this selective treatment. The district court's opinion is totally lacking in the *Graham* findings of the type required by the Federal Circuit in *Bausch & Lomb.* The District court did not cite *Graham* directly, made no reference at all to the "scope and content" of the prior art; made no

reference to the "level of skill" in the art; made no reference to the "differences" between the claims and the prior art. The absence of *Graham* findings precluded the *Graham* analysis.

If such an opinion is to stand as comporting with *Graham* as support for patent *validity* while the most rigorous *Graham* findings are required to support a holding of patent *invalidity,* the message to the lower courts and the bar will be loud, clear—and wrong.

Respectfully submitted,

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